UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,953	12/30/2003	Mary Rose Rice	14177-1600	7896

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EXAMINER
CASCHERA, ANTONIO A

ART UNIT	PAPER NUMBER
2628	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/748,953	RICE, MARY ROSE
	Examiner	Art Unit	
	Antonio A. Caschera	2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>17 November 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-8 and 10-15* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-8 and 10-15* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

DETAILED ACTION

Election/Restrictions

1.   Newly submitted claims 1-8 and 10-15 are directed to an invention that is independent or

distinct from the invention originally claimed for the following reasons:

The claims now seem to be directed to an invention that is performed without the use of

any type of computer or processing device (since the amendment now defines the sample cards

as, "physical paint color sample cards") which was not the case in view of the originally filed

claims.

Since applicant has received an action on the merits for the originally presented

invention, this invention has been constructively elected by original presentation for prosecution

on the merits. Accordingly, claims 1-8 and 10-15 are withdrawn from consideration as being

directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

2.   Applicant's arguments filed 11/17/06 have been fully considered but they are not

persuasive.

In reference to claims 1-8 and 10-15, Applicant traverses the previously made

election/restriction requirement based upon the original presentation of the claims (see pages 2-7

of Applicant's Remarks). Applicant goes on to explain that the claims, as originally filed, did

not recite the use of displaying the paint sample cards using a computer or computer display and

cites passages of the specification which describe the type of display as referred to by the claims

(see pages 3-5 of Applicant's Remarks). Applicant further argues that the amendment placing

the word "physical" into the current claim language, to provide, "physical paint sample cards" on

a "physical display," was performed in response to the previous Office Action where the Office

stated that the previously argued limitation of "physical paint sample cards" was not recited in

the claims (see pages 5-6 of Applicant's Remarks) and therefore was not considered.

The Office firstly points out that the original claims recited, "A method for displaying

color samples...placing the selected paint colors on a first plurality of sample cards ..." (see, for

example, claim 1 filed 07/15/04). The amendment filed 08/11/06 has modified claim 1, and all

other independent claims similarly, to recite, "A method of displaying paint color samples in a

two-dimensional physical display unit...placing the selected plurality of paint colors on a first

plurality of physical paint color sample cards..." It is clear that as originally filed, the claims

could be interpreted as being displayed on a computer display, using a computer program such as

the program cited as prior art, Microsoft PhotoDraw, since the sample cards of the claims could

be interpreted as color swatches programmed in Microsoft PhotoDraw. However, with the

newly amended claim language, it is clear that the scope of the claims has changed, since these

sample cards are now "physical" cards and not some type of element displayed by software.

Therefore, since the scope of the claims have changed from their original presentation, the Office

maintains the previous election/restriction requirement, making the requirement **FINAL**.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Antonio Caschera whose telephone number is (571) 272-7781.

The examiner can normally be reached Monday-Thursday and alternate Fridays between 7:00

AM and 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kee Tung, can be reached at (571) 272-7794.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

571-273-8300 (Central Fax)

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the Technology Center 2600 Customer Service Office whose telephone

number is (571) 272-2600.

aac

Antonio Caschera

12/19/06   Patent Examiner

KEE M. TUNG
SUPERVISORY PATENT EXAMINER